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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/680,622	10/06/2000	Gregory C. Flickinger	T728-10	9585

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TECHNOLOGY, PATENTS AND LICENSING, INC./PRIME
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EXAMINER

SALTARELLI, DOMINIC D

ART UNIT	PAPER NUMBER
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2611

DATE MAILED: 05/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	09/680,622		FLICKINGER, GREGORY C.	
	Examiner		Art Unit	
	Dominic D. Saltarelli		2611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>8/11/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

1. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

2. The abstract of the disclosure is objected to because it contains the phrase "Disclosed is..." on line 1, which should be removed. Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zigmond et al. (6,698,020, of record) [Zigmond] in view of Alexander et al. (6,177,931, of record) [Alexander].

Regarding claim 1, Zigmond teaches a method for delivering targeted advertising (col. 6, lines 1-12) in recorded programming (col. 14, lines 1-12), the method comprising:

Identifying subscribers likely to view the recorded programming (advertisement selection is based upon targeted demographics, col. 14, lines 35-48, geographic location and focus groups, col. 14, lines 49-58, and individual viewers of a household who subscribe to the disclosed service, col. 9 line 56 – col. 10 line 3);

Retrieving subscriber profiles associated with the identified subscribers (storage location 82 in fig. 5 holds the viewer profiles, col. 10, lines 48-63, which are subsequently used by ad selection module 83 for targeted ad selection, col. 11, lines 31-35); and

Delivering targeted advertisements targeted to the identified subscribers (col. 11 lines 31-49).

Zigmond fails to disclose receiving a schedule of programming to be recorded.

In an analogous art, Alexander teaches receiving from a user a schedule of programming to be recorded (fig. 6, col. 7 line 57 – col. 8 line 3), providing the user with a convenient means by which to record desired programming to be enjoyed at the user's leisure.

It would have been obvious at the time to a person of ordinary skill in the art to modify the method disclosed by Zigmond to include receiving a schedule of

programming to be recorded, as taught by Alexander, for the benefit of enabling users to designate programming for recording so the user can later watch said programming whenever the user desires.

Regarding claim 2, Zigmond and Alexander disclose the method of claim 2, wherein identifying subscribers is accomplished by characterizing the programming to be recorded (Zigmond teaches viewer recognition is accomplished through the monitoring of user selection of current programming, col. 9 line 65 – col. 10 line 3).

Regarding claim 3, Zigmond and Alexander disclose the method of claim 2, wherein receiving a schedule includes generating the schedule based on programming a recording device to record programming (Alexander, fig. 6, col. 7 line 57 – col. 8 line 3).

Regarding claim 4, Zigmond and Alexander disclose the method of claim 3, wherein programming a recording device is performed via an electronic program guide (Alexander, col. 7 line 57 – col. 8 line 3).

Regarding claim 5, Zigmond and Alexander disclose the method of claim 2, wherein said characterizing the programming is performed using data from an

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electronic program guide (Zigmond, electronic program database 81 in fig. 5, col. 10 line 64 – col. 11 line 8).

Regarding claim 6, Zigmond and Alexander disclose the method of claim 1, wherein said identifying subscribers is accomplished by analyzing data regarding subscriber interactions which an electronic program guide (Zigmond teaches subscribers [viewers] are identified by their programming choices, col. 9 line 65 – col. 10 line 3, wherein said programming choices are input through a program guide to designate desired programming for recording, as taught by Alexander, col. 7 line 57 – col. 8 line 3).

Regarding claim 7, Zigmond and Alexander disclose the method of claim 1, wherein said delivering targeted advertisements is done prior to recording the programming (Zigmond teaches ads are periodically downloaded and stored prior to selection and display, col. 10, lines 16-23).

Regarding claims 8 and 9, Zigmond and Alexander disclose the methods of claims 1 and 2, wherein said delivering includes inserting the targeted advertisements by comparing a profile of the advertisements with the subscriber (Zigmond teaches viewer information is used in conjunction with advertisement parameters to select advertisements, col. 11, lines 31-49).

Regarding claim 10, Zigmond discloses a method for delivering targeted advertising (col. 6, lines 1-12) in recorded programming (col. 14, lines 1-12), the method comprising:

Including avail opportunities (opportunities in which to insert advertisements) in programs (col. 7, lines 26-36 and col. 8, lines 30-54) and information about television programs (electronic program database 81 in fig. 5, col. 10 line 64 – col. 11 line 8);

Identifying and characterizing potential subscribers of the television programs (viewer recognition is accomplished through the monitoring of user selection of current programming, col. 9 line 65 – col. 10 line 3, and said monitoring is also used to characterize viewers, col. 10, lines 40-47);

Generating a schedule of a targeted advertisement to be delivered to the potential subscribers in avails within the television programs (step 110 of fig. 6, col. 17, lines 21-32); and

Delivering the targeted advertisement to the potential subscriber (step 116 in fig. 6).

Zigmond fails to disclose programming a recording device to record television programs and generating a schedule of programs to be recorded.

In an analogous art, Alexander teaches receiving from a user a schedule of programming to be recorded which programs a recording device (fig. 6, col. 7 line 57 – col. 8 line 3), providing the user with a convenient means by which to record desired programming to be enjoyed at the user's leisure.

It would have been obvious at the time to a person of ordinary skill in the art to modify the method disclosed by Zigmond to include receiving a schedule of programming to be recorded which programs a recording device, as taught by Alexander, for the benefit of enabling users to designate programming for recording so the user can later watch said programming whenever the user desires.

Regarding claims 11 and 13, Zigmond and Alexander disclose the method of claim 10, and further disclose characterizing the television programs using an electronic program guide database (Zigmond, electronic program database 81 in fig. 5 contains information which is used to characterize television programming, col. 10 line 64 – col. 11 line 8).

Regarding claim 12, Zigmond and Alexander disclose the method of claim 10, wherein said identifying and characterizing is performed using subscriber interaction data with an electronic program guide (Zigmond teaches subscribers [viewers] are identified by their programming choices, col. 9 line 65 – col. 10 line 3, wherein said programming choices are input through a program guide to designate desired programming for recording, as taught by Alexander, col. 7 line 57 – col. 8 line 3).

Regarding claim 14, Zigmond and Alexander disclose the method of claim 10, wherein the avail opportunities are derived from existing avails (Zigmond teaches triggering events are signals encoded into a programming feed, col. 8, lines 30-41).

Regarding claim 15, Zigmond discloses a system for delivering targeted advertising (col. 6, lines 1-12) in recorded programming (col. 14, lines 1-12), the system comprising:

A subscriber identification module (fig. 5, viewer and system information 82) for identifying possible subscribers that will view programs (advertisement selection is based upon targeted demographics, col. 14, lines 35-48, geographic location and focus groups, col. 14, lines 49-58, and individual viewers of a household who subscribe to the disclosed service, col. 9 line 56 – col. 10 line 3); and

An ad-scheduling module (fig. 5, ad selection criteria 83) for generating a schedule of a targeted ad to be inserted into the programs (col. 11, lines 31-49).

Zigmond fails to disclose a recording schedule module for obtaining a schedule of programs to be recorded.

In an analogous art, Alexander teaches receiving from a user a schedule of programming to be recorded (fig. 6, col. 7 line 57 – col. 8 line 3), providing the user with a convenient means by which to record desired programming to be enjoyed at the user's leisure.

It would have been obvious at the time to a person of ordinary skill in the art to modify the system disclosed by Zigmond to include an ad-scheduling module for obtaining a schedule of programs to be recorded, as taught by Alexander, for the benefit of enabling users to designate programming for recording so the user can later watch said programming whenever the user desires.

Regarding claim 16, Zigmond and Alexander disclose the system of claim 15, and further disclose a program characterization module (Zigmond, electronic program database 81 in fig. 5) for characterizing the programs (Zigmond, col. 10 line 64 – col. 11 line 8) to be recorded (Alexander, col. 7 line 57 – col. 8 line 3).

Regarding claim 17, Zigmond and Alexander disclose the system of claim 15, and further disclose a subscriber profile module (Zigmond, fig. 5, viewer and system information 82) for retrieving and updating a profile for each identified subscriber (Zigmond, col. 10, lines 35-47, wherein the updating is done for identified, individual viewers, col. 9 line 65 – col. 10 line 3).

Regarding claim 18, Zigmond and Alexander disclose the system of claim 15, and further disclose an ad-matching module (fig. 5, ad selection criteria 83) for matching ads to subscribers (col. 11, lines 31-49).

Regarding claim 19, Zigmond and Alexander disclose the system of claim 18, and further disclose an ad insertion module (Zigmond, fig. 5, ad insertion device 80) for inserting targeted ads (Zigmond, col. 11, lines 31-49) into the programs to be recorded (the programs in which ads are inserted are those which are taught to be recorded, Alexander, col. 7 line 57 – col. 8 line 3).

Regarding claims 20, 21, and 22, Zigmond and Alexander disclose the system of claim 15, and further disclose a recording program module ('Record Selection Function'), which is an element of an electronic program guide ('EPG'), for programming a recording device to record programming (Alexander, col. 7 line 57 – col. 8 line 3).

Regarding claim 23, Zigmond and Alexander disclose the system of claim 16, wherein said program characterization module utilizes data from an electronic program guide to characterize programming (Zigmond, col. 10 line 64 – col. 11 line 8).

Regarding claim 24, Zigmond and Alexander disclose the system of claim 15, wherein said subscriber identification module utilizes data comprising subscriber interactions with an electronic program guide to identify the subscriber (Zigmond teaches subscribers [viewers] are identified by their programming choices, col. 9 line 65 – col. 10 line 3, wherein said programming choices are

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input through a program guide to designate desired programming for recording, as taught by Alexander, col. 7 line 57 – col. 8 line 3).

5. Claims 25 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zigmond in view of Alexander and Klosterman et al. (6,078,348) [Klosterman].

Regarding claim 25, Zigmond discloses a method for delivering targeted advertisements in programs (col. 6, lines 1-12), the method comprising:

Including avails (advertisement insertion opportunities) within programs (col. 7, lines 26-36 and col. 8, lines 30-54);

Determining targeted advertisements to be delivered in a program (col. 11, lines 31-49); and

Delivering the targeted advertisements (col. 11, lines 31-49).

Zigmond fails to disclose flagging programs for future viewing, receiving notification that a program has been flagged for future viewing, generating a first schedule of programs that have been flagged for future viewing, and generating a schedule of target advertisements to be delivered in the flagged program.

In an analogous art, Alexander teaches receiving from a user a schedule of programming to be recorded (fig. 6, col. 7 line 57 – col. 8 line 3), providing the user with a convenient means by which to record desired programming to be enjoyed at the user's leisure.

It would have been obvious at the time to a person of ordinary skill in the art to modify the method disclosed by Zigmond to include flagging programs for

future viewing by receiving notification from a user that a program is flagged for future viewing and generating a schedule of programs that have been flagged for future viewing, as taught by Alexander, for the benefit of enabling users to designate programming for recording so the user can later watch said programming whenever the user desires.

Zigmond and Alexander fail to disclose a schedule of target advertisements to be delivered.

In an analogous art, Klosterman teaches an ad list data structure which provides a system with ad scheduling information well ahead of time (col. 8, lines 19-28).

It would have been obvious at the time to a person of ordinary skill in the art to modify the method disclosed by Zigmond and Alexander to include a schedule of target advertisements to be delivered, as taught by Klosterman, wherein said schedule would be generated by the ad insertion device (Zigmond, fig. 5, ad insertion device 80), for the benefit of providing the device with ad scheduling information well ahead of time, which would make the system less processor intensive, alleviating the requirement to calculate a new ad to insert at each and every opportunity.

Regarding claim 26, Zigmond, Alexander, and Klosterman disclose the method of claim 25, wherein said generating a schedule of targeted advertisements includes:

Retrieving a profile of potential advertisements (advertisement parameters associated with each ad, taught by Zigmond, col. 12, lines 15-32);

Retrieving a profile of the identified subscribers (Zigmond teaches viewers are first identified, col. 9 line 65 – col. 10 line 3, then viewer profile information is retrieved from the viewer and system information database, col. 11, lines 13-35);

Correlating the advertisement profile and each subscriber profile (Zigmond, col. 11, lines 31-49); and

Selecting the targeted advertisements based on said correlating (Zigmond, col. 11, lines 31-49).

Response to Arguments

6. Applicant's arguments filed November 19, 2004 have been fully considered but they are not persuasive.

On page 8, first paragraph and page 10, first paragraph of applicant's remarks, applicant states that Zigmond does not teach receiving a schedule of programming to be recorded and alleges that Zigmond does not teach identifying subscribers likely to view the recorded program.

In response, examiner first agrees the Zigmond does not teach receiving a schedule of programming to be recorded. However, as stated above regarding claim 1, Alexander is relied upon to remedy this deficiency. Further, Zigmond does teach identifying subscribers likely to view a recorded program, as stated

above regarding claim 1, because the system disclosed by Zigmond attempts to identify viewers based on current and past viewing habits, as cited above in col. 9 line 56 – col. 10 line 3, thus Zigmond relies on inexact prediction models to identify viewers who *may* view or be viewing a recorded program.

On page 8, third paragraph and page 10, last paragraph of applicant's remarks, applicant alleges that the motivation to combine the references is erroneous, as it is unclear to the applicant how the cited advantage of Alexander improves the system disclosed by Zigmond.

In response, examiner concedes that Zigmond does teach recording programs, but as stated above regarding claim 1, Zigmond fails to disclose receiving a *schedule* of programming to be recorded, which is a deficiency remedied by Alexander. The stated benefit applies to receiving a *schedule* of recording, not strictly to the ability to record. Receiving a schedule allows users to designate one or more programs for recording ahead of time, which improves the system disclosed by Zigmond, who is silent on how recording takes place.

On page 9, first paragraph, and page 11, second paragraph of applicant's remarks, applicant alleges that the motivation to combine the Zigmond reference with the Klosterman reference is erroneous, alleging that receiving scheduling information in advance does not change the operation of Zigmond.

In response, examiner simply restates the above stated advantage of lowering the processing the load on the system at the time of insertion. The modification of Zigmond in view of Klosterman would be faster and more responsive when inserting advertisements, as performing the selection process for the next advertisement prior to receiving the trigger for displaying an ad would mean the proper ad is immediately available, as opposed to having to perform a complicated selection process as quickly as possible in order to display the advertisement.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

8. The following are suggested formats for either a Certificate of Mailing or Certificate of Transmission under 37 CFR 1.8(a). The certification may be included with

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all correspondence concerning this application or proceeding to establish a date of mailing or transmission under 37 CFR 1.8(a). Proper use of this procedure will result in such communication being considered as timely if the established date is within the required period for reply. The Certificate should be signed by the individual actually depositing or transmitting the correspondence or by an individual who, upon information and belief, expects the correspondence to be mailed or transmitted in the normal course of business by another no later than the date indicated.

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Certificate of Mailing

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Please refer to 37 CFR 1.6(d) and 1.8(a)(2) for filing limitations concerning facsimile transmissions and mailing, respectively.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dominic D. Saltarelli whose telephone number is (571) 272-7302. The examiner can normally be reached on Monday - Friday 7:00am - 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Grant can be reached on (571) 272-7294. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Dominic Saltarelli
Patent Examiner
Art Unit 2611

DS


HAITRAN
PRIMARY EXAMINER